

Serial No.: 09/919,195; Conf. No. 4830
Docket No.: 17293DIV
Filed: July 31, 2001

prejudice, and therefore this rejection is now moot. Applicants thank the Examiner for indicating that the methods claims are now free of prior art.

Rejections Pursuant to 35 USC §112(1)

The Examiner has rejected claims 1-28 as allegedly not enabled by the specification. Claims 1-12 have been cancelled without prejudice; Applicants traverse this rejection as it may be held to apply to method claims 13-28.

The Invention is drawn to methods of using compositions that are RAR specific and have RAR β antagonist activity for the treatment or prevention of alveolar destruction and methods to increase the gas exchange surface area of a mammalian lung using such agents. The structures and syntheses of a multitude of RAR-specific antagonists is disclosed in the specification, within the U.S. Patents incorporated by reference on page 13, lines 2-4. Screening methods for finding those antagonists that inhibit RAR β , such as the transactivation assay described on page 13, lines 9 et seq., are also described in detail in the patents incorporated by reference. The specification discloses that the compounds can be administered for the desired purpose by any therapeutically effective manner or in any effective form, such as by way of a powder or liquid aerosol. Methods of making inhalants for treatment of lung conditions, such as asthma, are well known in the art.

The law requires that the invention be described in a manner that permits the person of ordinary skill in the art to make and use the invention; in this case, to carry out the method. In the case of a claim that involves a genus of ingredients, 35 U.S.C. 112(1) requires that a reasonable number of species be enabled. Applicants submit this is what has been done.

The Examiner has indicated that a number of compounds to be used in the claimed methods have been patented. While this may be true with regard to some species, a "new use of an old composition" is statutorily patentable subject matter. In addition, the fact that some compounds have been patented is an indication that these compounds at least are sufficiently enabled in the prior art to secure a patent directed thereto. Additionally, the presumably enabling disclosures of some of the patented compounds are incorporated by reference as part of this specification. As indicated above, methods for discovering other RAR-specific RAR β antagonists are provided in the specification, including in the material incorporated by reference. Finally, exemplary methods for the use of these compounds according to the claims are also present in the specification, e.g., on page 13.

For this reason, the Applicants respectfully request the Examiner to reconsider and withdraw this final ground for rejection, and permit the claims to proceed to issue.

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CONCLUSION

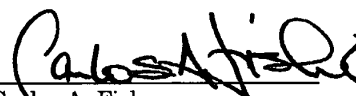
For these reasons, Applicants respectfully submit that the claims are in condition for allowance, and respectfully request that the Examiner issue a Notice to that effect. Should any fees be due in with this Reply, please use our Deposit Account No. 01-0885.

Respectfully submitted,

Dated: _____

8/16/02

By: _____



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